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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,282	06/27/2001	Akira Ishibashi	16869S-028500US	5229
20350	7590	12/10/2003	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LEE, SEUNG H	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/894,282	<b>Applicant(s)</b> ISHIBASHI ET AL.
	<b>Examiner</b> Seung H Lee	<b>Art Unit</b> 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 15 August 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-13 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \*    c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

1. Receipt is acknowledged of the amendment filed on 15 August 2003, which has been entered in the file.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. (US 5,691,525)(hereinafter referred to as 'Aoki') in view of Taylor (US 5,578,808).

Aoki teaches a financial transaction data processing system comprising a settling terminal (9) serving as a point exchange server receiving a first IC card (1) issued to an individual A by C bank and a second IC card (2) issued to an individual B by D bank, storing a certain amount of money in the first IC card that is deducted from the user account of C bank, the user A is inserting the first IC card into the setting terminal for transferring data to the second IC card in exchange for goods/services from the user B wherein a given price of goods/services is serving as a exchange rate, sending preliminary report to a host computer (11) of D bank, the first type of points and the second type of points are representing money/funds, the settling terminal comprising a plurality of devices for operating the transaction such as a memory (26) for storing

program, input devices (a keypad (16) and a pin pad (17)) for receiving user input, etc. (see Figs. 1-3; col. 1, lines 44-58; col. 2, line 7- col. 4, line 18).

However, Aoki fairly suggest or fails to particularly teach that the notifying the point exchange or transferring of data to a first server of card issuing company.

Taylor teaches a system for processing a multiple application data card or an IC card in which the system comprising database processing (56) for updating/recording at various locations (e.g., banking, reporting, updates, settlements, vendors, etc.) and the IC card, charging a transaction fee for renting the space for other companies to use the IC card for making transaction.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Taylor to the teachings of Aoki in order to provide an improved security for authenticating/verifying each and every transaction in real time by accessing the IC card issuing company for requesting a status of the IC card (e.g., lost, stolen, balance of account, etc.) for making proper/appropriate charges (e.g., the IC card is not lost nor stolen and the account has a adequate amount money for transaction), otherwise the transaction is prohibited (e.g., the IC card is reported as lost/stolen or the IC card account has not adequate amount of money for transaction). Moreover, such modification would provide a flexible transaction means for conducting each and every transaction without preliminary restriction such as amount transaction user(s) conduct as long as the user(s) has an enough funds in the account rather than user(s) is limited to the transaction amount that is downloaded/stored in the IC card from the banks or a ATM. Furthermore, such

modification (i.e., charging transaction fee) would provide an user-friendly system since user(s) can use multiple applications with single IC card.

Although, Aoki as modified by Taylor teaches the two different users (A and B) having two IC card issued by different banks, they fails to particularly teach that same company issues two different cards. However, it would have been an obvious to one of ordinary skill in the art at the time the invention was made to recognize that the particularly bank could manage transactions using two different IC card issued the bank if two user(s)/card holder(s) are customers of the same bank, for example, the user A and B can be both customers of the Bank of America, and the user A and B is conducting the transaction using the IC cards issued by the Bank of America, and therefore an obvious expedient.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

In response to the applicant argument that “....*a user may exchange his points from one card company for points of another card company in order to have enough points to receive a certain gift from that other company...*” (see page 6, line 8+), the Examiner respectfully provides a Aoki reference wherein the Aoki teaches the setting terminal for receiving two IC cards to transfer funds in order to complete financial transactions in which two IC cards are suing same points or money/funds as discussed

in paragraph 3 above. Accordingly, given its broadest reasonable interpretation, the teachings of Aoki as modified by Taylor meets the claimed limitations.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Shelton et al. [US 6,035,380] and Claus [US 5,461,217] disclose a method of transferring data using the smart cards and a system of using same.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Seung H. Lee** whose telephone number is (703) 308-

5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

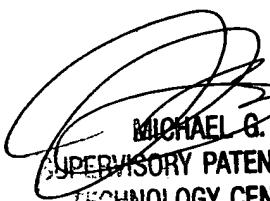
If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [\[seung.lee@uspto.gov\]](mailto:seung.lee@uspto.gov).

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
Seung H. Lee  
Art Unit 2876  
December 1, 2003

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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